

**REMARKS**

Claims 1-22 are all the claims pending in the application. By the present Amendment, Applicant seeks to amend claim 1.

In response to the Amendment filed May 6, 2004, the Examiner repeated the previous claim rejection. Thus, the status of the claims is the following.

Claims 1-5 and 7-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over previously-cited Yokota et al. (US 6,282,330, hereafter "Yokota") in view of previously-cited Luo et al. (US 6,654,506, hereafter "Luo"). Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant respectfully traverses the rejection, as set forth below.

Applicant submits that the prior art fails to teach or suggest the image synthesizing apparatus claimed in claim 1 of the present invention.

Claim 1 of the present application describes an image synthesizing apparatus in which a part of a second image is synthesized in a first image by background-foreground synthesizing. Yokota, as disclosed in Fig. 10, selects a plurality of images for printing as one page, from plural images. In Fig. 9, some layout patterns are shown, but these are not background-foreground synthesizing. In Yokota, there is no background image, since Yokota only overlaps plural images.

Also, Yokota does not disclose an inner frame. The Examiner refers to FIG. 9; col. 2, lines 59-60 and col. 12, lines 23-33 of Yokota in this regard. However, none of the cited portions of the reference disclose an inner frame. As described in col. 12 of Yokota, FIG. 9

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illustrates templates generally, but Yokota fails to disclose an inner frame located in the outer frame.

With regard to FIG. 10 of Yokota, a selected layout pattern is displayed in the upper right portion of the figure. However, this displaying portion does not display synthetic images with outer and inner frames.

Moreover, Yokota does not teach or suggest that the magnification of the first display section is larger than that of the second display section. As recited in claim 1, as amended herein, the first display section displays images at large magnification and the second display section displays images at small magnification. In addition, the synthetic image is displayed on the second display section. By contrast, Yokota fails to disclose that the magnification of the first display section is larger than that of the second display section.

Furthermore, Yokota uses templates to layout the selected images. The templates do not correspond to the first and second images of the present application. The first and second images of the present application are inputted into the synthesizing apparatus for image synthesizing, but the templates of Yokota are pre-contained in a ROM. In addition, the template corresponds to a mask plate having openings for cropping. In contrast, the first and second images of the present application are full-frame images which do not have cropped portions.

Luo discloses merely cropping images, and does not disclose the background-foreground image synthesis. In addition, Luo does not disclose the second display section displaying synthetic images with outer and inner frames.

Additionally, in the Amendment filed May 6, 2004, Applicant argued that the prior art fails to teach or suggest the crop boundary displayed on the image in the first display section, the

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crop boundary having a similar shape to the frame that is selected by the frame selecting device, as recited in claim 1. In the “Response to Arguments,” the Examiner asserts that Yokoto discloses trimming an image over a defined range and displaying the modified image as required by the designated page layout. Further, the Examiner asserts that Yokoto discloses, in FIG. 9, a rectangular frame region displaying a modified image cropped by a rectangular region. Applicant disagrees. FIG. 9 of Yokoto illustrates a template of the cover page of the book, which was selected by a user. There is no discussion in Yokoto of anything in FIG. 9 corresponding to a crop boundary displayed on the image, or of the crop boundary having a shape similar to the frame that is selected by the frame selecting device. Rather, the specification describes FIG. 9 as illustrating a book having a cover page, as shown in the left portion of the display screen. See col. 12, lines 23-37.

The discussion of “trimming” in Yokoto, which the Examiner likens to cropping, is quite limited. In col. 6, lines 28-35 of Yokoto, it is disclosed that the operator selects a template, and sets various parameters for the template (e.g., the number of images to be pasted, character input, design of background and slot window), further designates an image or images to be pasted. Then, for each image to be pasted, the operator inputs designations (instructions) for editorial processes, such as the direction and trimming of the image, when necessary. Neither this excerpt of the reference, nor the remainder of the reference, discloses or suggests the claimed crop boundary displayed on the image in the first display section, the crop boundary having a similar shape to the frame that is selected by the frame selecting device.

Furthermore, even though trimming of the image may be performed over a defined range of the image, the defined range of the image could consist of a boundary of a shape other than a

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shape similar to the shape of a crop boundary. The ambiguity of Yokota on this point should not be construed against the Applicant. See *In re Robertson*, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999). The Examiner's rejection is premised on a teaching of a modification of an image whereas the claim describes modification of a selected crop boundary.

Therefore, claim 1 and its dependent claims 2-5 and 7-22 are allowable over the prior art for this additional reason.

With further regard to claim 2, Applicant argued in the May 6 Amendment that Yokota fails to teach or suggest a device for enabling changing aspect ratio of any of said outer and inner frames. In the "Response to Arguments," the Examiner asserts that Yokoto's disclosure of reading multiple different resolutions corresponds to changing the aspect ratio, in that the differing resolutions indicate the number of pixels to be displayed horizontally and vertically. Applicant respectfully disagrees. The aspect ratio refers to the ratio of width to height of an image. By contrast, resolution refers to the number of pixels making up an image, regardless of the ratio between the width and height of the image. Thus, Yokoto does not disclose a device for enabling changing aspect ratio of any of said outer and inner frames, as recited in claim 2. Therefore, claim 2 is allowable for this additional reason.

Regarding claims 18 and 19, Applicant submits that Yokoto does not teach or suggest that the inner frame has one of a round shape, a triangular shape, a star shape, and a heart shape. The Examiner asserts that Yokoto teaches a polygonal shape. However, claims 18 and 19 do not claim a general polygonal shape. Instead, claims 18 and 19 recite an inner frame having one of a round shape, a triangular shape, a star shape, and a heart shape. Yokoto neither teaches nor suggests any of these more specific claimed shapes for the inner frame. Thus, whether FIG. 9 of

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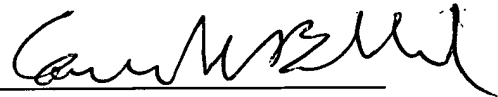
Yokoto shows a polygonal shape is irrelevant to the explicitly-recited features of claims 18 and 19, because a polygonal shape is not what is claimed in these claims. Thus, claims 18 and 19 are allowable for this additional reason.

With further regard to claims 20-21, these claims describe different resolutions for a main image and background image. The Examiner cites cols. 7-8 of Yokoto for teaching these features. However, the cited portion only pertains to a printer resolution and not to a relative resolution of main and background as claimed.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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